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10/655,571	09/04/2003	John A. Sazy	101896-706 (DEP-128CON)	6429
21125 7590 06/11/2010 NUTTER MCCLENNEN & FISH LLP SEAPORT WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604			EXAMINER PELLEGRINO, BRIAN E	
			ART UNIT 3738	PAPER NUMBER
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOHN A. SAZY

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Appeal 2009-007953  
Application 10/655,571  
Technology Center 3700

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Decided: June 9, 2010

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Before WILLIAM F. PATE, III, STEFAN STAICOVICI, and  
FRED A. SILVERBERG, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

John A. Sazy (Appellant) appeals under 35 U.S.C. § 134 (2006) from the Examiner's decision rejecting claims 1, 3, 5, 6, and 10-31. Claims 2, 4, and 7-9 have been canceled. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2006).

## THE INVENTION

Appellant's invention relates to an intervertebral prosthesis for implantation between adjacent vertebrae of the human spinal column. Spec. 2, ll. 22-23 and figs. 1 and 4.

Claim 1, the sole independent claim, is representative of the claimed invention and reads as follows:

1. An intervertebral prosthesis for implantation between adjacent vertebrae of the human spine, comprising:

a unitary body that is banana-shaped as viewed from above, the unitary body having an exterior surface and an interior surface, the interior surface defining an interior recess;

the unitary body defining openings that are evenly spaced about a circumference of the unitary body; and

wherein the banana shape of the unitary body includes a front arc that has a first radius of curvature and a back arc that includes a second radius of curvature.

## THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Dove	US 4,904,261	Feb. 27, 1990
Harms	US 4,820,305	Apr. 11, 1989

MacMillan	US 5,062,850	Nov. 5, 1991
McKay	US 5,702,449	Dec. 30, 1997
Schafer	US 6,143,032	Nov. 7, 2000
Preissman	US 6,231,615 B1	May 15, 2001
Michelson	US 6,302,914 B1	Oct. 16, 2001

The following rejections are before us for review:

The Examiner rejected claims 1, 3, 5, 6, 13, 14, 19, and 28 under 35 U.S.C. § 102(e) as anticipated by Schafer.

The Examiner rejected claim 30 under 35 U.S.C. § 102(e) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as unpatentable, over Schafer.

The Examiner rejected claims 10-12 under 35 U.S.C. § 103(a) as unpatentable over Schafer and Harms.

The Examiner rejected claims 15-18 and 20 under 35 U.S.C. § 103(a) as unpatentable over Schafer and Dove.

The Examiner rejected claims 24, 25, and 31 under 35 U.S.C. § 103(a) as unpatentable over Schafer and Michelson.

The Examiner rejected claim 21 under 35 U.S.C. § 103(a) as unpatentable over Schafer, Dove and MacMillan.

The Examiner rejected claims 22 and 23 under 35 U.S.C. § 103(a) as unpatentable over Schafer and Preissman.

The Examiner rejected claims 26, 27, and 29 under 35 U.S.C. § 103(a) as unpatentable over Schafer and McKay.

### OPINION

We shall not sustain the Examiner's rejection of claims 1, 3, 5, 6, and 10-31 under 35 U.S.C. §§ 102(b) and 103(a). For the reasons expressed

below, independent claim 1, and dependent claims 3, 5, 6, and 10-31, are inconsistent with Appellant's Specification and Drawings. Therefore, the prior art rejections must fall because they necessarily are based on speculative assumptions as to the meaning of the claims. *See In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejections.

### NEW GROUNDS OF REJECTION

We make the following new grounds of rejection pursuant to 37 C.F.R. § 41.50(b)(2007).

Claims 1, 3, 5, 6, and 10-31 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The definiteness of claim language must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971). *See also In re Cohn*, 438 F.2d 989, 993 (CCPA 1971) (sustaining rejection of claims under 35 U.S.C. § 112, second paragraph, as being indefinite, where the claims were inherently inconsistent with the description, definitions, and examples appearing in applicant's specification).

Independent claim 1 requires a *banana-shaped* unitary body as depicted in Figure 4 of Appellant's Drawings. *See also* Spec. 4, 1. 3.

Figure 4 of Appellant's Drawings is reproduced below:

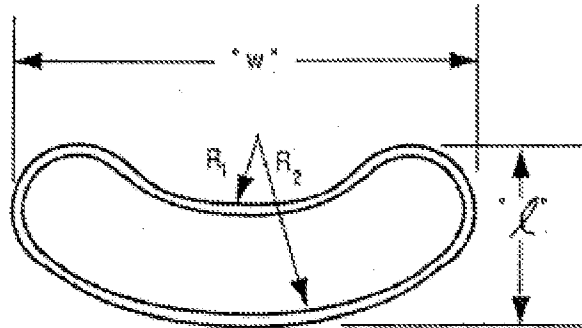
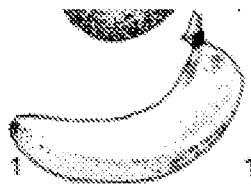


FIG. 4

Figure 4 of Appellant's Drawings depicts the length "l", the width "w", the front arc radius of curvature "R<sub>1</sub>", and the back arc radius of curvature "R<sub>2</sub>" of a spinal implant.

Appellant "defines 'banana' as follows: 'the *elongated often curved and usu. tapering* fruit of the banana plant.'" App. Br. 8.<sup>1</sup> As an example, of a banana shape, we provide the following Figure:<sup>2</sup>



The Figure depicts a banana.

<sup>1</sup> Like Appellant, we find that an ordinary and customary meaning of the term "banana" is "an elongated *usu. tapering* tropical fruit." MERRIAM WEBSTER'S COLLEGIATE DICTIONARY (10<sup>th</sup> Ed. 1997).

<sup>2</sup> THE MACMILLAN VISUAL DESK REFERENCE, Tropical fruits 1547 (1993).

After comparing the shape of Appellant's claimed "banana-shaped" unitary body (as per Figure 4 of Appellant's Drawings) with the definition provided by Appellant for a banana shape and the Figure, we do not find that Appellant's illustrated spinal implant is *banana-shaped*, as required by independent claim 1. Although the shape shown in Figure 4 of Appellant's Drawings is elongated and curved, it is not tapering.

Hence, claim 1 "do[es] not define the invention (*i.e.*, the subject matter which the applicant regards as his invention) with a reasonable degree of particularity." *In re Hammack*, 427 F.2d 1378, 1382 (CCPA 1970). In other words, we conclude that *banana-shaped* as used in the claims, when construed in view of Appellant's Figure 4, lacks sufficient precision so that one endeavoring to practice the invention could not determine the metes and bounds thereof.

In light of the above, we conclude that claim 1, which includes the *banana-shaped* limitation, and claims 3, 5, 6, and 10-31 which depend from claim 1, are inherently inconsistent with the description that appears in Appellant's Specification and Drawings.

#### SUMMARY

The decision of the Examiner to reject claims 1, 3, 5, 6, and 10-31 is reversed.

We enter new grounds of rejection of claims 1, 3, 5, 6, and 10-31 under 35 U.S.C. § 112, second paragraph.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b)(2007). 37 C.F.R. § 41.50(b) provides "[a] new ground of

rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

REVERSED; 37 C.F.R. § 41.50(b)

mls

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